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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,036	07/07/2004	Alfonso Branca	22990	1492
7590	03/23/2006		EXAMINER	
The Firm of Karl F Ross 5676 Riverdale Ave Box 900 Riverdale (Bronx), NY 10471			VOGELBACKER, MARK T	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/501,036	BRANCA, ALFONSO	

<b>Examiner</b>	<b>Art Unit</b>	
Mark T. Vogelbacker	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 February 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 25-30,32-36,38-41,43 and 44 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 25-30,32-36,38-41,43 and 44 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 July 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

***Claim Objections***

1. Claims 35, 36, 38-41, 43 and 44 are objected to because of the following informalities:

Regarding claim 35, line 4, the phrase “at by” does not make sense.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 25-30, 32-36, 38-41, 43 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 25, line 12, the phrase “of both of said core members” is confusing. Are there adhesives used to form the core members that are not used to bond the first material to the second material?

Claims 25 and 35 recite a material with "predominantly high mechanical characteristics" and "predominantly high elastic characteristics". How high is "predominantly high" and how would one of ordinary skill in the art recognize the metes and bounds of these claims?

Regarding claim 44, what defines an “ergonomic shape”?

***New Grounds of Rejection***

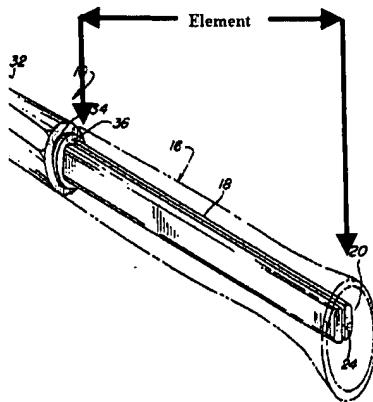
***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 25-27, 29, 30, 32-36, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rust et al., US-5,588,343 in view of Kusznir, US-4,721,021 and further in view of Remmert et al., US-5,530,989.

Rust discloses the invention as claimed, including two elongated pultruded (col 3, ln 24) core members (18) constituted of a thermoplastic resin embedded with natural and synthetic fibers (col 3, lns 24-25). The core members (18) extend alongside one another over a full length of the element (see figure below).



Rust discloses a bearing (16) of a second material inserted between the elongated members (18) and a layer (48) covering the elongated members (18). The bond between the first and second material is formed without the use of adhesives (col 3, lns 32-34). Rust does not mention that the

core members move relative to one another in a longitudinal direction. Examiner notes that it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. Kusznir teaches the invention as claimed, including at least two elongated core members (R) and a bearing (W) of a second material inserted between the elongated members (R). Further, Kusznir teaches that the element allows small relative longitudinal displacement of the core members (R) (col 5, lns 10-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the element of Rust to allow small relative longitudinal displacement of the core members, as taught by Kusznir, to absorb the primary shock forces encountered without loss or impairment of control of the element (col 5, lns 25-27). Rust and Kusznir do not mention that the second material is chemically bonded to the first material. Remmert teaches the invention as claimed, including a first material (14) and a second material (12). These materials are chemically bonded without the use of adhesives (col 3, lns 45-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the element of Rust and Kusznir to chemically bond the materials, as taught by Remmert, to strengthen the element (col 1, lns 44-46).

Regarding claims 27, 29 and 30, Remmert teaches that the second material is composed of an elastomeric polymer, particularly thermoplastic polyurethane (col 2, lns 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the layer to be made of an elastomeric polymer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Regarding claims 35, 36, 39 and 39, the Office considers the method of making the handle device obvious to the structures disclosed by Rust, Kusznir and Remmert. Therefore, the method of making the handle is given little patentable weight as claimed.

Regarding claim 36, the bonding of the first material and the second material is effected by the application of heat in that the thermoplastic polyurethane used by Remmert requires the appropriate heat to form the material. Therefore, the Office considers that the bonding of the materials is “effected” by heat.

6. Claims 28, 40, 41, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rust et al., US-5,588,343 in view of Kusznir, US-4,721,021 in view of Remmert et al., US-5,530,989 and further in view of Edwards, US-6,184,286 B1.

Rust, Kusznir and Remmert teach the invention as claimed, but do not mention that the thermoplastic resin is engineered polyurethane thermoplastic polymer (ETPU). Edwards, US-6,184,286 B1 teaches the use of ETPU as an efficient and effective means of dispersing a filler material into a thermoplastic resin. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the handle of Rust, Kusznir and Remmert to include material comprising ETPU, as taught by Edwards, US-6,184,286 B1, to provide a carrier that is compatible with the target resin, thereby allowing for the efficient dispersion of the filler material in a polymer matrix (col 1, lns 36-39).

Regarding claims 40, 41 and 43, the Office considers the method of making the handle device obvious to the structures disclosed by Rust, Kusznir, Remmert and Edwards, US-6,184,286 B1. Therefore, the method of making the handle is given little patentable weight as claimed.

Art Unit: 3677

7. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rust et al., US-5,588,343 in view of Kusznir, US-4,721,021 in view of Remmert et al., US-5,530,989 in view of Edwards, US-6,184,286 B1 and further in view of Edwards, US-2002/0063349 A1.

Rust, Kusznir, Remmert and Edwards, US-6,184,286 B1 disclose the invention as claimed, but do not mention the technique of thermoforming to mold the handle. Edwards, US-2002/0063349 A1 teaches the technique of thermoforming to shape pultruded elements (pg 2, [0016], lns 6-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Rust, Kusznir, Remmert and Edwards, US-6,184,286 B1 to provide a step of thermoforming, as taught by Edwards, US-2002/0063349 A1, to further shape the handle to the desired form.

The Office considers the method of making the handle device obvious to the structures disclosed by Rust, Kusznir, Remmert, Edwards, US-6,184,286 B1 and Edwards, US-2002/0063349 A1. Therefore, the method of making the handle is given little patentable weight as claimed.

#### *Response to Arguments*

8. Applicant's arguments filed February 17, 2006 regarding rejections over Rust et al., US-5,588,343 have been fully considered but they are not persuasive.

Regarding Applicant's arguments on page 7, lines 11-25, Merriam-Webster's dictionary defines "discrete" as "individually distinct". As can be seen from the figure in paragraph 5 above, Rust discloses two, individually distinct, elongated, pultruded (col 3, ln 24) core members (18). Further, the Examiner agrees that Rust does not disclose that the core members are

Art Unit: 3677

“capable of” shifting longitudinally relative to one another. However, this is why the Examiner has combined Rust with Kusznir to reject claims 25 and 35.

9. Applicant's arguments with respect to the rejection over Epel et al., US-4,334,563 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments filed February 17, 2006 regarding rejections over Remmert et al., US-5,530,989 have been fully considered but they are not persuasive.

Regarding Applicant's arguments on page 8, lines 14-24, Remmert is clearly within the field of the inventor's endeavor, that is tool handles. One of ordinary skill in the art attempting to improve tool handles would look to the teachings of other tool handles, such as Remmert, for suggestions and previous combinations of materials.

11. Regarding Applicant's argument on page 9, lines 4-12, the combination of Rust and Kusznir, found within the tool handle art, teach two discrete elongated members capable of shifting longitudinally relative to one another.

### *Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 3677

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Vogelbacker whose telephone number is (571) 272-1648. The examiner can normally be reached on 8:00 am - 5:30 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MTV

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